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10/091,573	03/07/2002	Carl Joseph Kraenzel	042846-0312968	7969
53796 7590 07/30/2009 PILLSBURY WINTHROP SHAW PITTMAN, LLP c/o SUSAN TRADER 1650 TYSONS BOULEVARD P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER NGUYEN, TAN D				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6  
7

8 *Ex parte* CARL JOSEPH KRAENZEL, KATHERINE A. SPANBAUER,  
9 and MARK A. NOWACKI  
10

11  
12 Appeal 2009-002793  
13 Application 10/091,573  
14 Technology Center 3600  
15

16  
17 Decided:<sup>1</sup> July 30, 2009  
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20 *Before:* MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH  
21 A. FISCHETTI, *Administrative Patent Judges*.

22  
23 CRAWFORD, *Administrative Patent Judge*.  
24  
25

26 DECISION ON APPEAL  
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28 STATEMENT OF THE CASE

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 1, 2, 4 to 6, 8, 12, 14, 15, 17 to 19, 21, 25 to 27, 29 to 31, 33, and 37. We have jurisdiction under 35 U.S.C. § 6(b) (2002). Appellants appeared for oral hearing on June 23, 2009.

Appellants invented a system and method for identifying synergistic opportunities within and between organizations which includes determining whether the person's monitored activities match some or all of the information in the database that is related to a declared topic (Specification 1 to 2).

Claim 1 under appeal reads as follows:

1. A computer-implemented method, comprising the steps of:  
enabling one or more users to declare, and associate information with, one or more topics, wherein associated information for a declared topic comprises at least one of a topic description, or one or more keywords relating to the topic;  
storing declared topics and their associated information;  
monitoring computing activities of a user;  
determining if the user appears to be interested in a declared topic based on the monitored activities and based on the declared topic's associated information; and  
notifying the user of the existence of the declared topic if it appears that the user is interested in the declared topic.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Tang	US 5,960,173	Sep. 28, 1999
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The Examiner rejected claims 1, 2, 4 to 6, 8, 12, 14, 15, 17 to 19, 21, 25 to 27, 29 to 31, 33, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Tang.

## ISSUES

Have Appellants shown that the Examiner erred because Tang fails to teach or suggest enabling one or more users to declare and associate information with one or more topics?

Have the Appellants shown that the Examiner erred because there is no objective evidence of motivation or suggestion to modify Tang?

Have the Appellants shown that the Examiner erred because Tang does not disclose storing declared topics with their associated information and determining if the user appears to be interested in a declared topic?

## FINDINGS OF FACT

The Specification discloses that an entity declares a topic by inputting data into a database information regarding the topic. The information inputted may include the name of the topic, a description of the topic, one or more keywords related to the topic, the reason for declaring the topic, access limitations, an expiration date, the name of a group e-mail address, the name of a virtual team workspace, a link (e.g., a uniform resource locator (URL)) to an electronic bulletin board, one or more links to a web page, and/or other information (Specification 5).

Tang discloses a system that provides awareness of users of other users that are task proximate. Users are task proximate if they are working on the same or related data or with the same or related application at about

the same time (col. 2, ll. 32 to 37). When a user is accessing a particular function or particular data, the information is represented by file names, object names, pointers or other means (col. 13, ll. 17 to 20). The Encounter aware application sends the status message to an encounter proxy object which sends a status message that specifies the data or function the user is currently using (col. 13, ll. 20 to 24). The encounter server receives the status messages of users and stores the status messages (col. 14, ll. 3 to 6). The encounter server compares the stored status messages and identifies status messages that include the same application type or application name or other matching criteria, and sends the position data included in the status message to a match object for determining whether the users are task proximate (col. 14, ll. 18 to 25).

## PRINCIPLES OF LAW

### Obviousness

An invention is not patentable under 35 U.S.C. § 103 if it is obvious. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007). The facts underlying an obviousness inquiry include: Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In addressing the findings of

fact, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”

*KSR* at 416. As explained in *KSR*:

If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraid* and *Anderson's-Black Rock* are illustrative - a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

*KSR* at 417. A prior art reference is analyzed from the vantage point of all that it teaches one of ordinary skill in the art. *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968) (“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.”). Furthermore, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR* at 421.

*Printed Matter*

Nonfunctional descriptive material cannot render nonobvious an invention that is otherwise obvious over the prior art. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art); *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

Common situations involving nonfunctional  
descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium,
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

*Compare Ex parte Curry* (BPAI 2005) (<http://www.uspto.gov/web/offices/dcom/bpai/its/fd050509.pdf>) (Informative Opinion). Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material. *See also Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (Informative Opinion).

CLAIM CONSTRUCTION

Appellants argue that the cited prior art not disclose the limitation recited in claim 1 of “enabling one or more users to declare, and associate information with, one or more topics.” As such, the construction of this clause is at the heart of the patentability determination in this case.

Appellants’ Specification discloses that an entity *declares* a topic by inputting information regarding the topic into a database. In addition, as the claim recites “enabling one or more users” the step of declaring or inputting data is not positively recited in the claim. Rather the claim is directed to a method that makes it possible or enables a user to input information into a database.

ANALYSIS

We are not persuaded of error on the part of the Examiner by Appellants’ argument that the Examiner erred because Tang fails to teach or suggest enabling one or more users to declare and associate information with one or more topics. First, as the claim recites “enabling . . . users to declare,” the claim does not recite that a topic *is* declared but merely that a user is able to declare a topic. In addition, as the act of declaring is merely the act of entering information into a database, this ability to declare a topic is clearly disclosed in the Tang reference as the users are able to input information in the Tang reference from which a status message is created.

With regard to the specific information inputted, i.e., topic or keyword information, it is our holding that the type of information inputted is non-functional descriptive matter that does not affect the patentability of the claims. The Appellants have not come forward with evidence sufficient to



1 show that the structure of the database containing the data or the process of  
2 inputting the data it is functionally affected by the data being, specifically,  
3 topic and keyword information. Absent such evidence, it is reasonable to  
4 conclude that the topic and keyword aspect of the information is merely  
5 descriptive and as such is not patentably consequential.

6 Still further, even if the type of information inputted and stored were  
7 patentably significant, we agree with the Examiner that the modification of  
8 Tang so as to match topic and keyword information rather than matching  
9 application and data worked on information would have been an obvious  
10 modification because the use of topics and keywords are well known  
11 matching criteria.

12 We are not persuaded of error by the Examiner based on Appellants'  
13 allegation that there is no objective evidence of motivation or suggestion to  
14 modify Tang. As we noted above, it is our holding that the specific  
15 information that is used for matching is non-functional descriptive matter  
16 and as such no modification of Tang is needed. And as detailed in the  
17 preceding paragraph, there is ample motivation to use topic and keyword  
18 information as matching criteria in Tang.

19 In view of the foregoing, we will sustain the Examiner's rejection of  
20 claim 1, we will also sustain the Examiner's rejection of claims 2, 4 to 6, 8,  
21 12, 14, 15, 17 to 19, 21, 25 to 27, 29 to 31, 33, and 37 because the  
22 Appellants have not argued the separate patentability of these claims.

## 23 24 CONCLUSION OF LAW

25 On the record before us, Appellants have not shown that the Examiner  
26 erred in rejecting the claims.

DECISION

The Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2008).

AFFIRMED

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PILLSBURY WINTHROP SHAW PITTMAN, LLP  
c/o SUSAN TRADER  
1650 TYSONS BOULEVARD  
P.O. BOX 10500  
MCLEAN, VA 22102